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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,299	12/01/2003	Mark L. Anderson	01639.000014.	6104

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EXAMINER

MCCORMICK EWOLDT, SUSAN BETH

ART UNIT PAPER NUMBER

1661

DATE MAILED: 09/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/726,299	<b>Applicant(s)</b> ANDERSON ET AL.	
	<b>Examiner</b> S. B. McCormick-Ewoldt	<b>Art Unit</b> 1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-25 is/are allowed.
- 6) ☒ Claim(s) 20-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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**DETAILED ACTION**

The amendment of August 8, 2006 is hereby acknowledged and entered.

**Status of Application**

The Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1661.

**Election/Restriction**

Applicant elected species, grape seed extract, election in the reply filed on January 11, 2005.

**Claims Pending**

Claims 20-25 have been examined on the merits.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20-23 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Internet website Huddleston (2000) in view of Cui *et al.* (KR 2003073441- abstract only) in view of Wada (JP 408092028-abstract only) for reasons set forth in the previous Office action which are restated below. Applicant's arguments filed August 8, 2006 have been fully considered but they are not persuasive.

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Internet website Huddleston (2000) discloses that green tea has shown to be an antibacterial and proven to have the ability to kill *Bacterium acne*, the bacteria that causes acne (page 2, second paragraph).

Internet website Huddleston (2000) does not disclose wherein the green tea extract is combined with grape seed extract or 1,3-butylene glycol.

Cui *et al.* (KR 2003073441) disclose that *Vitis vinifera* (i.e. grape) extract contains tannins that are antibacterial and have an effect against *Propionibacterium acne* and is used in an antibacterial composition (see abstract).

Wada (JP 408092028) disclose that 1,3-butylene glycol is used as a humectant in a cosmetic in inhibiting and the effects of *acne vulgaris* (see abstract).

One of ordinary skill in the art would have been motivated to add grape seed extract and green tea extract into a topical composition to treat acne because grape seed extract and green tea extract are known to have antibacterial properties and would be advantageous to be used in compositions that treat acne. It was clear from Huddleston (2000) that green tea extracts have antibacterial properties and have been used to treat acne. It was further clear from Cui that *Vitis vinifera* contains antibacterial effects which are used against *Propionibacterium acne* and it was further clear from Wada that 1,3-butylene glycol is used in compositions that treat acne. It is clear that the combination of extracts would have been effective in treating *Propionibacterium acne* and *Bacterium acne*. Therefore, one of ordinary skill in the art would have had a reasonable expectation that, because of their beneficial anti-microbial properties, to combine grape seed extract and green tea extract in a composition to treat acne.

These references show that it was well known in the art at the time of the invention to use grape seed extract and green tea extract in a composition to treat acne. It is well known that it is *prima facie* obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. *In re Pinten*, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); *In re Susi*, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); *In re Crockett*, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960).

Based on the disclosure by these references that grape seed extract and green tea extract are used in compositions to treat acne, an artisan of ordinary skill would have a reasonable expectation that a combination consisting essentially of grape seed extract and green tea extract would be useful for treating acne. Therefore, the artisan would have been motivated to combine the claimed ingredients into a single composition. No patentable invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients. See *In re Sussman*, 1943 C.D. 518; *In re Huellmantel* 139 USPQ 496; *In re Crockett* 126 USPQ 186.

*Response to Arguments*

Applicant's arguments concerning the above art rejection have been fully considered but are not deemed to be persuasive. **Applicant argues** that Huddleston does not suggest the use of green tea extract in a topical composition to treat acne (page 7 of response). This is not found persuasive because extracts are routinely used in compositions because of the concentrated properties (antioxidants, minerals, oils bioflavonoids, etc.) that extracts contain. With regard to Applicant's argument to Huddleston not disclosing a topical composition Applicant is reminded that the adjustment in conventional working conditions (e.g., incorporating a plant extract within a commonly employed delivery vehicle routinely used for acne agents- such as topical application) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

In response to **Applicant's arguments** against the Cui reference individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

**Applicant argues** that it cannot be fairly said that Wada's teaching of the use of 1,3-butylene glycol can be applied to all anti-acne compositions (page 7 of response). This is not persuasive because Wada shows that 1,3-butylene glycol is used in acne composition. One of ordinary skill in the art would know that 1,3-butylene glycol is commonly used as a humectant in cosmetic formulations to inhibit the drying out of the cosmetic.

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In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon impermissible hindsight analysis, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

As discussed in the rejection *supra*, these references show that it was well known in the art at the time of the invention to use grape seed extract and green tea extract in a composition to treat acne. It is well known that it is *prima facie* obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. *In re Pinten*, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); *In re Susi*, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); *In re Crockett*, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960).

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Therefore the rejection is proper and is maintained.

Allowable Subject Matter

Claims 24 and 25 appear to be free of the prior art because the prior art does not teach the specific amounts of grape seed extract, green tea extract, 1,3-butylene glycol and water. Therefore, claims 24 and 25 are allowed.

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Summary

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiners' supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975. The official fax number for the group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sbme



CHRISTOPHER R. TATE  
PRIMARY EXAMINER